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Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

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EXAMINER'S ANSWER

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GROUP 3600

1. This is in response to the brief on appeal filed January 24, 2001.

Status of Claims

2. The statement of the status of claims 28-59 contained in the brief is correct.
3. The statement of the status of the claims 1-27 contained in the brief is incorrect. A correct statement of the status of the claims is as follows: claims 1-27 would be allowed if any of claims 28-59 are allowed. Since claims 1-27 have not been amended, recapture does not apply to these claims.

Status of Amendments After Final

4. The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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Summary of Invention

5. The summary of invention contained in the brief is correct.

Issues

6. The appellant's statement of the issues in the brief is substantially correct.

The changes are as follows: since claims 1-27 have not been amended, recapture does not apply to these claims. Recapture applies to claims 28-59.

Grouping of Claims

7. The rejection of claims 1-59 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

ClaimsAppealed

8. The copy of the appealed claims contained in the Appendix to the brief is correct.

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Prior Art of Record

9. No prior art is relied upon by the examiner in the rejection of the claims under appeal.

No new prior art has been applied in this examiner's answer.

Grounds of Rejection

10. The following ground(s) of rejection are applicable to the appealed claims:

Claims 28-59 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See Hester Industries, Inc. V. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. V. United States, 729 F2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

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application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by filing of the present reissue application.

Claim 28 was rejected as being anticipated by Darnell et al in serial No. 07/978272. Applicant argued on page 21 in amendment A in serial No. 07/978272 that the Darnell et al patent does not teach “an event sensor that determines when a selected trigger event involving the vehicle has occurred and issuing a sensor output signal when that event occurs; controller means, connected to the GPS receiver/processor and to the event sensor, for receiving the event sensor output signal and, in response thereto, for issuing a first output signal that is received by the GPS receiver/processor that commands the receiver/processor to determine and issue as an output signal the present location of the receiver/processor, and for receiving the receiver/processor output signal representing present location of the receiver/processor and issuing this present location information as a second output signal”.

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Page 21 in amendment A in Serial No. 07/978272 states: "(1) The Darnell et al user location system requires that GPS unit always be activated and that the associated cellular unit always be transmitting the present location of the user who carries that GPS unit. In the invention recited in claims 27-30 of the patent application, a GPS or other location determining unit and a cellular means are carried on a vehicle, but the combined location determining unit and cellular means are activated only when a receiver carried on the vehicle receives a vehicle location or paging request signal from a central station. The electrical current or power supplied by a power supply for this combination is thus conserved through maintenance of the system in a "sleep mode" most of the time. The system is activated only when (a) the vehicle is moved in an unauthorized manner or (b) some other specific event occurs, as sensed by an event sensor located on or adjacent to the vehicle."

Claim 28 recited in serial No. 07/978272 was allowed in view of the limitation recited above. Any reissue claim must have this limitation, since it was this limitation that the record (page 21 in amendment A) showed was the reason claim

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28 was allowed and by arguing this limitation, applicant surrendered any claim lacking this limitation. This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 1 was combined with the subject matter of dependent claim 11 to form independent claim 32. As a result the subject matter of dependent claim 11 was the reason independent claim 32 was allowed. Any reissue claim must have the limitation of dependent claim 11, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 32 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 11.

Dependent claim 11 states: "The method of claim 1, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of gyroscopes and associated vehicle angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular orientation of said vehicle; a vehicle velocity sensor to determine and issue an output signal indicating the present velocity of said vehicle; and a receiver/processor

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that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 1 was combined with the subject matter of dependent claim 12 to form independent claim 33. As a result the subject matter of dependent claim 12 was the reason independent claim 33 was allowed. Any reissue claim must have the limitation of dependent claim 12, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 33 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 12.

Dependent claim 12 states: “The method of claim 1, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of local magnetic field angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular orientation of said vehicle; a vehicle velocity sensor to determine and issue an output signal indicating the present

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velocity of said vehicle; and a receiver/processor that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 13 was combined with the subject matter of dependent claim 25 to form independent claim 35. As a result the subject matter of dependent claim 25 was the reason independent claim 35 was allowed. Any reissue claim must have the limitation of dependent claim 25, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 35 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 25.

Dependent claim 25 states: “The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of gyroscopes and associated vehicle angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular

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orientation of said vehicle; a vehicle velocity sensor to determine and issue an output signal indicating the present velocity of said vehicle; and a receiver/processor that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 13 was combined with the subject matter of dependent claim 26 to form independent claim 36. As a result the subject matter of dependent claim 26 was the reason independent claim 36 was allowed. Any reissue claim must have the limitation of dependent claim 26, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 36 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 26.

Dependent claim 26 states: “The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of local

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magnetic field angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular orientation of said vehicle; a vehicle velocity sensor to determine and issue and output signal indicating the present velocity of said vehicle; and a receiver/processor that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment B in serial No. 07/978272, the subject matter of independent claim 31 was combined with the subject matter of dependent claim 10 to form independent claim 39. As a result the subject matter of dependent claim 10 was the reason independent claim 39 was allowed. Any reissue claim must have the limitation of dependent claim 10, since it was this limitation that the record (amendment B in serial No. 07/978272) shows was the reason claim 39 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 10.

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Dependent claim 10 states: "The method of claim 1, further comprising the step of choosing said vehicle location receiver/processor to be a LORAN signal receiver/processor that receives time-coded LORAN signals from a plurality of LORAN signal transmitters and determines said vehicle location from these signals." This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment B in serial No. 07/978272, the subject matter of independent claim 34 was combined with the subject matter of dependent claims 23 and 24 to form independent claim 41. As a result the subject matter of dependent claims 23 and 24 was the reason independent claim 41 was allowed. Any reissue claim must have the limitations of dependent claims 23 and 24, since it was these limitations that the record (amendment B in serial No. 07/978272) shows was the reason claim 41 was allowed and applicant surrendered any claim lacking the limitations recited in dependent claims 23 and 24.

Dependent claim 23 states: "The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to be a GPS signal

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receiver/processor that receives time-coded GPS signals from one or more satellites and determines said vehicle location from these signals.”

Dependent claim 24 states: “The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to be a LORAN signal receiver/processor that receives time-coded LORAN signals from a plurality of LORAN signal transmitters and determines said vehicle location from these signals.”

These limitations are not present in claims 28-59 in serial No. 08/862039.

Claims 28-59 recapture claimed subject matter deliberately canceled in application serial Number 07/978,272.

For example:

Claims 28-33 in serial Number 08/862,039 recapture subject matter from canceled claim 31 in serial Number 07/978,272.

Claim 31 in the patent, which recited the method of determining the location of the vehicle was rejected and canceled (combined with claim 10 to form allowable claim

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39, renumbered as claim 7). Claim 31 contained detailed structure. Newly filed claim 28 attempts to recapture subject matter canceled (the method without the limitations of claim 10) but also broadened the claims in aspect directly related to the rejection of claim 31 in the in the patent file. Likewise claim 27, in the patent, recited apparatus of a similar scope to that of claim 31 and was canceled. Claim 30 of the reissue recaptures such canceled claim language, and additionally broadens that subject matter in an aspect directly related to the rejection of claim 27 of the patent file.

In the amendment filed January 27, 2000, Applicant indicated that none of the claims are broader in all aspects than the canceled claims, and are in fact narrower in some aspects. Detailed justification of this position was requested.

With regard to the examples recited above, claim 31 in the patent application was canceled (combined with claim 10 to form allowable claim 39, renumbered as claim 7). Comparing new claim 28 to canceled claim 31; it is broader in all aspects, The patented claim 7 required the subject matter of claim 10 to be allowable. Therefore Applicant “surrendered” claimed subject matter not including the limitations of claim 10. Applicant argues that each claim is allowable over the references for

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various structural reasons (limitations). These limitations are what make the claims allowable and are required to remain in the reissue claims as the Applicant has “surrendered” subject matter not containing the limitations.

There are two ways to determine recapture: by comparison to canceled claims, and by determining what limitations made the patent claims allowable. A reissue claim can not be broader than a canceled claim in all aspects, and all reissue claims must retain at least one of the reasons (limitations) which made the patent claims allowable.

Response to Argument

11. The Appellant has grouped the claims on appeal (1-59) in three categories, A, B, and C.

Group A: patented claims 1-27. Since these claims have not been amended or changed, the recapture doctrine does not apply.

Group B: claims 28-49, 54, 55, 58, and 59. These claims recite a communications device capable of operation independent of a paging request responder.

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Group C: claims 50-53, 56, and 57. These claims recite a noncellular paging request responder.

The Group B claims (claim 54 for example) have been broadened since the patented claims 1-27 recite a communication device which is coupled to the output of the paging device. To function, the communication device must receive the output of the paging device. Claims 1-27 do not recite a communications device capable of operation independent of a paging request responder. As a result, the Group B claims (claim 54 for example) are broader than patented claims 1-27. Further evidence of broadening can be demonstrated since various elements recited the patented claims 1-27 are not present in the Group B reissue claims (28-49, 54, 55, 58, and 59). For example: "controller means, connected to the GPS receiver/processor and to the event sensor, for receiving the event sensor output signal and, in response thereto, for issuing a first output signal that is received by the GPS receiver/processor that commands the receiver/processor to determine and issue as an output signal the present location of the receiver/processor, and for receiving the receiver/processor output signal representing present location of the

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receiver/processor and issuing this present location information as a second output signal" (claim 1), "A plurality of gyroscopes and associated vehicle angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle" (claim 3), "a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle" (claim 4), "a plurality of gyroscopes and associated vehicle angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle" (claim 5), "a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle", (claim 6), "providing a vehicle with a LORAN signal antenna and receiver/processor, connected to the antenna, where the antenna and receiver/processor receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the location of a selected vehicle location from these signals" (claim 7), and "providing a vehicle with a vehicle location signal antenna and a receiver/processor, connected to the antenna, where the vehicle location signal antenna and

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receiver/processor are drawn from the class consisting of (I) a GPS signal antenna and a receiver/processor that receive time-coded GPS signals from one or more satellite and determine the present location of a selected vehicle from these signals and (ii) a LORAN signal antenna and receiver/processor that receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the present location of a selected vehicle from these signals" (claim 17), are not present in the Group B claims (28-49, 54, 55, 58, and 59).

The Group B claims (claim 54 for example) relate to subject matter that Appellant previously surrendered during the prosecution of the application. Claim 38 found in application 07/978,272 recites a communication device capable of operating independently of a paging request responder since the communication means recited in claim 38 is responsive to an event sensor output signal, not a paging signal. Since claim 38 was canceled in the amendment filed June 22, 1994, the "communications device capable of operation independent of a paging request responder" subject matter found in the Group B claims (28-49, 54, 55, 58, and 59) has been surrendered. The same analysis that applies to claim 54 also applies to the rest of

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the claims in Group B (28-49, 55, 58, and 59) since these claims variously contain the “communications device capable of operation independent of a paging request responder” subject matter which was surrendered when claim 38 found in application 07/978,272, was canceled.

The Group C claims (claim 56 for example) have been broadened since the patented claims 1-27 do not recite a noncellular paging request responder. Further evidence of broadening can be demonstrated since various elements recited the patented claims 1-27 are not present in the Group C reissue claims (50-53, 56, and 57). For example: “controller means, connected to the GPS receiver/processor and to the event sensor, for receiving the event sensor output signal and, in response thereto, for issuing a first output signal that is received by the GPS receiver/processor that commands the receiver/processor to determine and issue as an output signal the present location of the receiver/processor, and for receiving the receiver/processor output signal representing present location of the receiver/processor and issuing this present location information as a second output signal” (claim 1), “A plurality of gyroscopes and associated vehicle angular orientation sensors attached to the

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vehicle to determine and issue output signals indicating the present angular orientation of the vehicle" (claim 3), "a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle" (claim 4), "a plurality of gyroscopes and associated vehicle angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle" (claim 5), "a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle", (claim 6), "providing a vehicle with a LORAN signal antenna and receiver/processor, connected to the antenna, where the antenna and receiver/processor receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the location of a selected vehicle location from these signals" (claim 7), and "providing a vehicle with a vehicle location signal antenna and a receiver/processor, connected to the antenna, where the vehicle location signal antenna and receiver/processor are drawn from the class consisting of (I) a GPS signal antenna and a receiver/processor that receive time-coded GPS signals from one or more satellite and determine the

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present location of a selected vehicle from these signals and (ii) a LORAN signal antenna and receiver/processor that receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the present location of a selected vehicle from these signals" (claim 17), are not present in the Group C claims (50-53, 56, and 57).

The Group C claims (claim 56 for example) relate to subject matter that Appellant previously surrendered during the prosecution of the application. Claim 37 recites a "noncellular paging request responder". Claim 37 was canceled in the amendment filed June 22, 1994. As a result, the "noncellular paging request responder" subject matter found in the Group C claims (50-53, 56, and 57) has been surrendered. The same analysis that applies to claim 56 also applies to the rest of the claims in Group C (50-53 and 57) since these claims variously contain the "noncellular paging request responder" subject matter which was surrendered when claim 37 found in application 07/978,272, was canceled.

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12. It is the Examiner's contention that the rejection of claims 28-59 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is correct and should be sustained.

13. Any inquiry concerning this communication should be directed to Theodore Blum at telephone number (703) 305-1833.

CONF.

TMB
GCI
THT

Theodore M. Blum
THEODORE M. BLUM
PRIMARY EXAMINER